

Appl. No. 10/801,475
Reply to Office Action of September 12, 2005

Attorney Docket No. 2003-1410 / 24061.193
Customer No. 42717

REMARKS

Claims 1-20 are currently pending in the application. The Office Action mailed on September 12, 2005 indicates that it is presenting both a restriction requirement and an election-of-species requirement. These two requirements are addressed separately below.

Restriction Requirement

In response to the restriction requirement set forth on pages 2-3 of the Office Action, Applicants elect Group I (Claims 1-14 and 19-20). This election is made without traverse.

Election-Of-Species Requirement

In section 3 on pages 3-4, the Office Action indicates that it is setting forth an election-of-species requirement. Applicants respectfully traverse this requirement for two different reasons, which are discussed separately below.

First, Applicants respectfully traverse this requirement because it is not in proper form. In this regard, Applicants are not addressing the issue of whether or not some species are patentably distinct. Instead, Applicants are respectfully pointing out that the Office Action fails to properly identify any "species" on which an election-of-species requirement can properly be based. MPEP § 806.04(c) emphasizes with italics that:

Claims are definitions of inventions. *Claims are never species . . .*
Species are always the specifically different embodiments.
(Emphasis in original).

Page 3 of the Office Action identifies Species "I" by referring to Claims 1-14 and by listing some elements recited in independent Claim 1. Similarly, the Office Action identifies Species "II" by referring to Claims 19-20 and by listing some elements recited in independent Claim 19. In other

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words, the Office Action attempts to identify two "species" solely by reference to the claims. In essence, the Office Action asserts that certain claims constitute one species, and other claims constitute a different species. But this approach is specifically prohibited by MPEP §806.04, which emphasizes that "*Claims are never species*". This improper approach also causes the Office Action to have internal inconsistencies. For example, the Office Action specifies which claims go with which species, but then instructs Applicants to provide "a listing of all claims readable" on the elected species, or in other words a listing of all claims readable on the claims identified by the examiner. This makes no sense (and the reason is that the Office Action does not actually identify any true species). According to official PTO policy, the proper way to identify different species in the vast majority of patent applications is by identifying different drawing figures (or by identifying different examples in the case of a chemical invention). More specifically, MPEP §809.02(a) explains that, in a proper election-of-species requirement:

The species are preferably identified as the species of figures 1, 2, and 3 or [in a chemical case] the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species *cannot be conveniently identified*, the claims may be grouped in accordance with the species to which they are restricted.
(Emphasis in original).

In other words, if it is possible to do so, the examiner must identify species by figure numbers. In the rare event that it is simply not possible to identify species by figure numbers, then and only then the examiner may identify the species by mechanical means, particular material, or other distinguishing characteristic. And in the extremely rare event that species "*cannot be*

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conveniently identified" in any of these various different ways, then and only then the examiner may group claims (but even then it must be remembered that "*Claims are never species*" and that the claims must be grouped "in accordance with the species", as opposed to using the claims to define the species).

As a practical matter, it is an extremely rare situation where an examiner is able to carry the burden of showing that species "*cannot be conveniently identified*" in any of the various different ways preferred by MPEP §809.02(a), such that the examiner can resort to grouping claims. In the present Office Action, the Examiner has not carried the burden of demonstrating that species "*cannot be conveniently identified*" in any of the various different ways preferred by the PTO. Accordingly, the Examiner was not entitled to resort to grouping claims. The Office Action therefore fails to properly identify any species on which an election-of-species requirement could properly be based. The purported election-of-species requirement is thus inherently defective, and it is respectfully submitted that it must be withdrawn.

The second independent reason for Applicants' traverse of this requirement relates to the fact that, since the Examiner has merely grouped claims, there is no practical difference between the so-called election-of-species requirement and a standard restriction requirement (such as the restriction requirement set forth in section 2 on pages 2-3 of the Office Action). Stated differently, when the two requirements in sections 2 and 3 of the Office Action are considered together, they are no different than a single three-way restriction requirement that groups the claims as follows:

- Group A - Claims 1-14.
- Group B - Claims 15-18.
- Group C - Claims 19-20.

However, in section 2 on pages 2-3 of the Office Action, the Examiner indicates that Claims 1-14 and 19-20 all fall within class 257, subclass 734. Accordingly, since election of any of Claims 1-14 and 19-20 will require a search of this class and subclass, the Examiner can examine all of Claims 1-14 and 19-20 without any undue additional burden. And in the absence of undue

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burden, the official PTO position is that an examiner should not require restriction or election. Accordingly, there is no good reason for requiring any restriction and/or election as among Claims 1-14 (Group A) and Claims 19-20 (Group C). This is a further reason why the requirement set forth on pages 2-3 of the Office Action is not proper, and must be withdrawn.

The PTO requires that Applicants reply to a restriction or election requirement, even if Applicants offer a valid traverse. Accordingly, as between Claims 1-14 and Claims 19-20, Applicants elect Claims 1-14. Obviously, Claims 1-14 all read on the so-called "species" of Claims 1-14. Further, since this so-called "species" is defined solely by the subject matter of Claims 1-14, at least independent Claim 1 is necessarily generic.

Conclusion

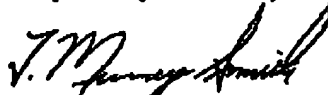
Further and favorable consideration of this application is respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

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Although Applicants believe that no fee is required by this paper, the Commissioner is hereby authorized to charge any fees required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone, LLP.

Respectfully submitted,



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Date: October 12, 2005

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Enclosures: None

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